



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,154	08/01/2005	Francis X. Smith	3009099 US01	6432
44331	7590	04/19/2010		
HISCOCK & BARCLAY, LLP			EXAMINER	
2000 HSBC PLAZA			BASQUILL, SEAN M	
100 Chestnut Street				
ROCHESTER, NY 14604-2404			ART UNIT	PAPER NUMBER
			1612	
			MAIL DATE	DELIVERY MODE
			04/19/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.	Applicant(s)	
10/544,154	SMITH, FRANCIS X.	
Examiner	Art Unit	
Sean Basquill	1612	

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED **05 April 2009** FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) The period for reply expires 3 months from the mailing date of the final rejection.
 b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) They raise the issue of new matter (see NOTE below);
 (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. Applicant's reply has overcome the following rejection(s): _____.

6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-20

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fail to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
 See Continuation Sheet

12. Note the attached *Information Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). _____

13. Other: _____

/Jeffrey S. Lundgren/
 Primary Examiner, Art Unit 1639

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's reliance on *In re Baird* is misplaced within the factual context of the instant application, and, as put forth previously, Chowhan fails to "teach away from" the proffered combination as asserted by applicants. *Baird* concerned the rejection as obvious of a particular species that undeniably fell within a genus disclosed in the prior art. *Baird*, as well as its predecessor case *In re Jones*, concerned the impropriety of rejecting as obvious claims to particular species when the prior art disclosed genera encompassing, on one hand more than 100 million, and on the other "a potentially infinite genus" of compounds, respectively. Here, the examiner's *prima facie* conclusion of obviousness rests on the prior art's disclosure of a genus containing merely 20 members, namely the naturally occurring amino acids. Given the teaching of Chowhan, that any amino acid can be used as an enhancer of antimicrobial efficiency, and the finite and limited scope of the genus of compounds disclosed as suitable for providing such utility, the holding of *In re Baird* cannot apply to the instant analysis of obviousness under the holding of *Graham v. John Deere* and its progeny. Applicants' alternative argument, that the teachings of Chowhan teach away from the combination of EDTA and L-histidine, likewise fails, this time for the reasons put forth previously. Specifically, while certain preferred embodiments of the invention disclosed within the context of Chowhan do not include EDTA, and the purpose of the invention, arguably the "most preferred embodiment" disclosed in Chowhan is to avoid the use of EDTA, Chowhan expressly acknowledges that EDTA is commonly and widely used as an ophthalmic preservative. A reference that expressly acknowledges the utility of a particular component cannot logically be said to teach away from that precise use. As a result, applicants have failed to properly overcome the examiner's *prima facie* case of obviousness, as no objective indicia of nonobviousness commensurate in scope with the invention claimed has properly been presented which will permit the examiner to conclude that results achieved by applicants invention are in fact an unexpected improvement over the prior art.